



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/818,824 | 03/27/2001 | Christopher Y. Chen | 41747/DBS/C843 | 9989 |

23363 7590 07/31/2006

CHRISTIE, PARKER & HALE, LLP
PO BOX 7068
PASADENA, CA 91109-7068

EXAMINER

COLBERT, ELLA

ART UNIT PAPER NUMBER

3693

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 09/818,824 | Applicant(s) CHEN, CHRISTOPHER Y. | |
| | Examiner Ella Colbert | Art Unit 3693 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 18-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-31 are pending in this communication filed 05/02/06 entered as Response to Election/Restriction. Group I, Claims 1-17 have been elected without traverse and Group II, Claims 18-31 have been withdrawn.

Title Objection

2. The title of the invention is objected to because: The title of the invention recites "SYSTEM AND METHOD FOR PROVIDING AUTOMATIC TELLER MACHINE SERVICES TO MULTIPLE FINANCIAL INSTITUTIONS". The title would be better recited as "SYSTEM FOR PROVIDING AUTOMATED TELLER MACHINE SERVICES TO MULTIPLE FINANCIAL INSTITUTIONS".

Abstract

3. The abstract is objected to because the abstract contains over 150 words.

Content of Specification

- (k) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).

Correction is required. See MPEP § 608.01(b).

Specification

4. The Specification is objected to because page 1, line 14 has the acronym "ATM". This line should begin with "Automatic Teller Machine (ATM)" or "Automated

Teller Machine (ATM)". Page 7, lines 21, 24, 30, 31, and 34 have a problem with "services" and "service". Throughout the Specification, claims, and in the abstract both "ATM services provider" and "ATM service provider" are recited. It is unclear whether there is an "ATM services provider" and an "ATM service provider". This needs to be clarified in the Specification, claims, and abstract. There is inconsistency in the Specification, claims, and abstract. Also, it is unclear whether Applicants' mean "Automatic Teller Machine" or "Automated Teller Machine".

Page 8, line 1, recites "form or checks ...". This line should recite "form of checks ...".

Page 9, line 30 recites "FIG. 3 is a diagram illustrating an embodiment the present".

This line would be better recited, as "FIG. 3 is a diagram illustrating an embodiment of the present". Page 19, line 2 recites, "6,1454,738, describes one such system ". This line should read "6,145,738, describes one such system". Figures 2 and 3, element "20" is labeled "access fee" in the drawing and referenced as "access fees"; element "22" in the drawing is labeled "Interchange fee revenue" and referenced as "interchange fees"; Figure 3, element "16" is labeled "ATM" and referenced as "ATMs" in the Specification. Figure 7, element "133" is not mentioned in the Specification. Correction is required. See MPEP § 608.01(b).

Drawings

5. The drawings are objected to under 37 CFR 1.83(a) because they fail to show Figure 4, element "102" and "106" and Figure 7, element "140" as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected

drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

6. Claims 1 and 3 are objected to because of the following informalities: the acronyms ATM and EFT. Claim 1 in the preamble should recite "Automatic Teller Machine (ATM)" or "Automated Teller Machine (ATM)" and claims 2-17 should recite "Automatic Teller Machine (ATM)" or "Automated Teller Machine (ATM)" and claim 3 should recite "Electronic Funds Transfer (EFT)". Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 3693

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1, page 23 recites in claim limitation three "the ATM service provider ...". This claim limitation should recite "An ATM service provider ...".

Claims 2-17 are also rejected since they depend from a rejected base claim.

Conclusion

9. The application is not in condition for allowance because there are many outstanding issues that need to be resolved prior to an examination on the merits of the claims.

Inquiries

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3693

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

July 22, 2006


ELLA COLBERT
PRIMARY EXAMINER